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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/733,628 | 12/11/2003 | Russell Bonaventura | LEAP:127US | 1669 |

7590 11/08/2005

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| EXAMINER | |
|---|---|
| LAVARIAS, ARNEL C | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2872 | |

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|---|---|---|
| | 10/733,628 | BONAVENTURA ET AL. |
| | Examiner | Art Unit |
| | Arnel C. Lavarias | 2872 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *01 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-6,9-15 and 17-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,9-15 and 17-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 September 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Drawings*

1. The drawings were received on 9/1/05. These drawings are acceptable.

### *Response to Amendment*

2. The amendments to the specification of the disclosure in the submission dated 9/1/05 are acknowledged and accepted. In view of these amendments, the objections to the specification in Sections 3-5 of the Office Action dated 6/14/05 are respectfully withdrawn.

3. The amendments to Claims 1-2, 4, 9-15, 17-19 in the submission dated 9/1/05 are acknowledged and accepted.

4. The cancellation of Claims 7-8, 16 in the submission dated 9/1/05 is acknowledged and accepted.

### *Response to Arguments*

5. The Applicants' arguments, see in particular Pages 9-11, 16 of Applicants' remarks, filed 9/1/05, with respect to the rejections of Claims 1, 9, and 17, have been fully considered and are persuasive. The rejections of Claims 1-20 in Sections 7-14 of the Office Action dated 6/14/05 have been withdrawn.

6. The Examiner additionally notes the disqualification of Zimmermann et al. under 35 U.S.C. 103(c) (See in particular Pages 12-15 of the submission dated 9/1/05).

7. Claims 1-6, 9-15, 17-20 are now rejected as follows.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 9, 11, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas-Hamilton et al. (U.S. Patent No. 5306467), in view of Kapitza et al. (U.S. Patent No. 5781338), of record.

Douglas-Hamilton et al. discloses a microscope stage (See Figures 1-4) comprising an upper stage (See 10 in Figure 1); and a non-transparent contrasting stage insert (See 20 in Figure 1; col. 4, lines 40-45) comprising a second color, the non-transparent contrasting stage insert comprising a portion of the upper stage background (See specifically Figure 2). Douglas-Hamilton et al. additionally discloses the non-transparent contrasting stage insert comprising a magnetic surface (See Figure 4); the upper stage comprising a recess and the non-transparent contrasting stage insert being operatively arranged for releasable complementary receipt therein (See 14, 10, 20 in Figure 1); the non-transparent contrasting stage insert comprising alignment means (See 24, 26 in Figure 1), such as recess pins and corresponding bores; and the non-transparent contrasting stage insert further comprising fastening means (See Figure 4). Douglas-Hamilton et al. does not explicitly disclose the upper stage comprising a first color. However, Kapitza et al.

discloses a microscope stage (See Figures 1-3) comprising an upper stage comprising a first color, e.g. black as by black lacquer paint (See col. 1, lines 6-24), and including a recess therein (See for example 7 in Figure 1). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the upper stage of the microscope stage of Douglas-Hamilton et al., comprise a first color, as taught by Kapitza et al., for the purpose of preventing contamination of the stage and maintaining the good appearance of the stage during use and storage.

10. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas-Hamilton et al. in view of Kapitza et al.

Douglas-Hamilton et al. discloses the invention as set forth above in Claim 9, except for the non-transparent contrasting stage insert comprising a painted surface. However, as previously set forth above in Claim 9, Kapitza et al. teaches a microscope stage (See Figures 1-3) comprising an upper stage comprising a first color, e.g. black as by black lacquer paint (See col. 1, lines 6-24). The lacquer paint is used mainly to protect and maintain the surface finish of the stage during usage. One of ordinary skill would have known to protect other various parts of the microscope and microscope stage, such as stage inserts and sample holders, using the lacquer paint, to similarly protect and maintain the surface finish of these other various parts. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the non-transparent contrasting stage insert comprise a painted surface in the microscope stage of Douglas-Hamilton et al. in view of Kapitza et al., to protect and maintain the surface finish of the stage insert during use and storage.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas-Hamilton et al. in view of Kapitza et al.

Douglas-Hamilton et al. in view of Kapitza et al. discloses the invention as set forth above in Claim 9, except for the non-transparent contrasting stage insert comprising an adhesive film. However, the use adhesive films, magnets/magnetic surfaces and springed detents for use as releasable fastening means to allow for easy removal and attachment of items is well known and conventional in the art. For example, as previously set forth above, Douglas-Hamilton et al. discloses the non-transparent contrasting stage insert further comprising fastening means, such as magnets. Although the use of adhesive films is not specifically taught by Douglas-Hamilton et al. or Kapitza et al. for use as fastening means, such adhesive films, such as double-sided tape, is well known in the art for use in attachment applications. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the non-transparent contrasting stage insert comprise an adhesive film, to provide for precise and accurate positioning of the insert, while allowing for quick removal and replacement of the insert when needed.

12. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas-Hamilton et al. in view of Kapitza et al.

Douglas-Hamilton et al. in view of Kapitza et al. discloses the invention as set forth above in Claims 9, 11, 13-15, except for the non-transparent contrasting stage insert not explicitly being removable. However, Douglas-Hamilton et al. additionally discloses that the non-transparent contrasting stage insert (See 20 in Figure 1 of Douglas-Hamilton et al.) may be inserted into the upper stage (See 10 in Figure 1 of Douglas-Hamilton et al.)

by inserting the lateral extensions (See 24 in Figure 1 of Douglas-Hamilton et al.) on the legs of the stage insert into the bores (See 26 in Figure 1 of Douglas-Hamilton et al.) in the recess of the upper stage. Thus, it would be reasonable for one of ordinary skill to be able to similarly remove the stage insert from the upper stage by disengaging the lateral extensions on the legs of the stage insert from the bores of the recess of the upper stage. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the non-transparent contrasting stage insert be removable, to allow for quick removal and replacement of the insert, during operation of the microscope, particular during times where the insert becomes damaged or a different insert is required.

13. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas-Hamilton et al. in view of Kapitza et al. as applied to Claims 1, 4, 9 above, and further in view of Fischer et al. (U.S. Patent No. 4436385).

Douglas-Hamilton et al in view of Kapitza et al. discloses the invention as set forth above in Claims 1, 4, 9, except for the releasable fastening means comprising a springed detent. However, the use adhesive films, magnets/magnetic surfaces and springed detents for use as releasable fastening means to allow for easy removal and attachment of items is well known and conventional in the art. For example, Fischer et al. teaches a conventional specimen holder for use in microscopes (See Abstract; Figures 1-3), wherein slidable holders (See 2a, 2b in Figure 1) for holding a specimen is releasably held in place at a particular position by springed detents (See 21a, 21b in Figure 1; col. 2, line 52-col. 3, line 4). Thus, it would have been obvious to one having ordinary skill in

the art at the time the invention was made to have the releasably fastening means comprise a spring detent, as taught by Fischer et al., in the microscope stage of Douglas-Hamilton et al. in view of Kapitza et al., to provide for precise and accurate positioning of the insert, while allowing for quick removal and replacement of the insert when needed.

14. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas-Hamilton et al. in view of Sattler (U.S. Patent No. 4906083).

Douglas-Hamilton et al. discloses a device (See Figures 1-4) for providing contrast between a microscope stage (See 10 in Figure 1) and a specimen (See 21, 23, 25 in Figure 2A; col. 4, lines 9-15) comprising a microscope stage comprising a non-transparent contrasting stage insert having a first color (See 20 in Figure 1; col. 4, lines 40-45); and a specimen (See col. 4, lines 9-15). Douglas-Hamilton et al. additionally discloses the non-transparent contrasting stage insert being releasably secured to the microscope stage (See Figure 2), wherein the non-transparent contrasting stage insert comprises a releasable fastening means, such as a magnet (See Figure 4). Douglas-Hamilton et al. does not explicitly disclose the specimen having a second color being different from the first color of the non-transparent contrasting stage insert. However, it is well known in the art that many of the specimens examined by microscopes will have some color, which may be different from that of the stage (e.g. black) and/or a stage insert (e.g. silver, black). For example, Sattler teaches a conventional microscope for examining gemstones (See Abstract; Figures 1-2), wherein the gemstones (i.e. the specimen) may have a color that is different from the microscope stage (See 10 in Figures

1-2; col. 8, lines 3-28) or the sample holder/insert (See 54 in Figures 1-2; col. 4, line 60-col. 6, line 2) on which the sample is placed. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made for the specimen have a second color be different from the first color of the non-transparent contrasting stage insert, as taught by Sattler, in the device of Douglas-Hamilton et al., to allow for higher contrast, while maintaining or reproducing accurate and true color of the specimen, during viewing of the specimen.

***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arnel C. Lavarias whose telephone number is 571-272-2315. The examiner can normally be reached on M-F 9:30 AM - 6 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on 571-272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Arnel C. Lavarias
11/7/05

THONG NGUYEN
PRIMARY EXAMINER
GROUP 2800

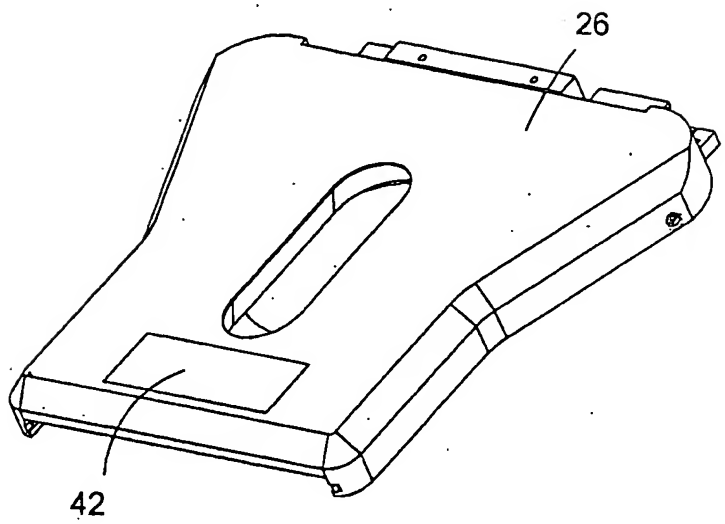


Fig. 6

Drawing Changes Approved
11/4/05

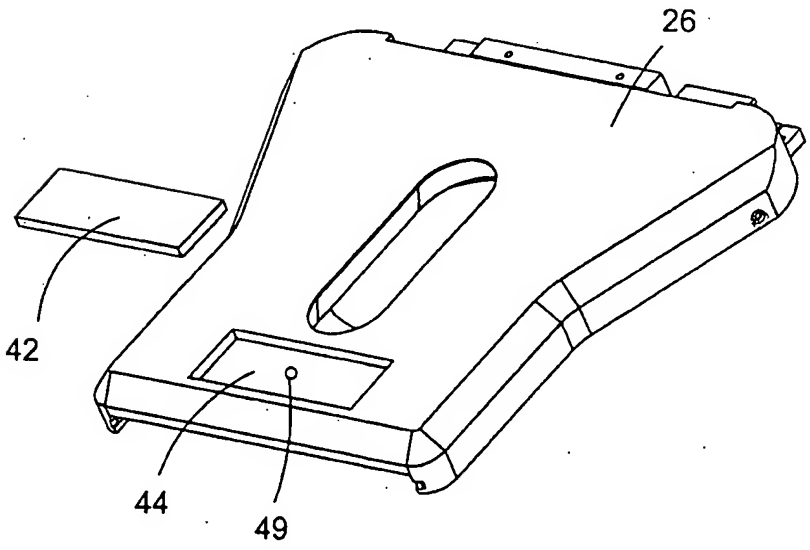


Fig. 7